



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,854	03/31/2005	Kojiro Tanaka	052343	5346
38834	7590	07/20/2007	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP			SHEN, BIN	
1250 CONNECTICUT AVENUE, NW			ART UNIT	PAPER NUMBER
SUITE 700			1657	
WASHINGTON, DC 20036			MAIL DATE	DELIVERY MODE
			07/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/529,854	TANAKA, KOJIRO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bin Shen	1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 April 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 17 and 18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 9-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date.
- 5) Notice of Informal Patent Application
- 6) Other:

**DETAILED ACTION**

The IDS received 3/31/2005, the preliminary amendment received 3/31/2005 have been entered.

***Election***

Applicant's election without traverse of Group I, claims 1-4, 9-16, in the reply filed on 4/27/2007 is acknowledged.

Claims 5-8, 17, 18 are nonelected and thus are withdrawn from further consideration.

Only claims 1-4, 9-16 are presented for examination on the merits.

***Specification***

1. The abstract of the disclosure is objected to because the abstract must be a single paragraph. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using

Art Unit: 1657

phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Objections***

2. Claim 16 is objected to as depending from a non-elected claim. The Examiner recommends rewriting Claim 16 to incorporate all the language of Claim 5, from which it depends.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 10-11, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai et al. (Proceedings of the Society for Experimental Biology and Medicine 1986;183:74-80).

Tsai et al. teach a measuring kit (abstract and page 75, Fig.1) of microorganisms in a liquid sample comprising a first syringe, a flocculant (read as syringe pump), a first filter case (page 75, right column, 1<sup>st</sup> full paragraph), a second filter case, a second syringe (end of page 75 to beginning of page 76), a washing liquid (page 76, line 7); a bacteriolytic agent (page 75, left column, 2<sup>nd</sup> full paragraph), a measuring tube, a luminous reagent (page 76, 2<sup>nd</sup> full paragraph), a luminometer (page 76, right column, 1<sup>st</sup> full paragraph), wherein the filtering material of a pore diameter of about 1  $\mu\text{m}$  to about 10

Art Unit: 1657

µm as the first filter (page 75, right column, 1<sup>st</sup> full paragraph, lines 18-19), wherein the second filter is a porous polymer membrane having pores of a pore diameter of about 0.1 µm to about 0.5 µm (page 76, left column, line 1), wherein a sterile distilled water is added to the sample (page 75, Fig. 1).

Claims 1-2, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Trudil (USPN6395504B1).

Trudil et al. teach a measuring kit (abstract) of microorganisms in a liquid sample comprising a first syringe, a flocculant, a first filter case (col. 4, lines 3-9), a second filter case, a second syringe (col. 4, 12-14), a washing liquid (col. 4, line 25); a bacteriolytic agent (col. 2 lines 63-64), a measuring tube, a luminous reagent, a luminometer (col. 4, lines 30-39); wherein the filter cases are disposable (col. 4, lines 12, 15).

Therefore, the cited reference is deemed to anticipate the instant claims above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1657

4. Claims 1-4, 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tsai et al. in view of Trudil et al. and Tanaka et al. (Wat. Res. 1997;31(8):1913-1918).

Tsai teaches what is above.

Tsai does not teach a filtering accelerating agent, the filter cases are disposable, using of ethanol.

Trudil teaches what is above and that the filter cases are disposable (col. 4, lines 12, 15).

Tanaka teaches a measuring kit of microorganisms that filter with a suction pump (page 1914, bottom of right column), and the ATP extractive reagent contains ethyl alcohol (page 1914, right column, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Tsai by using a filtering accelerating agent (such as a suction pump), using ethanol, and using disposable filter cases as taught by Trudil and Tanaka because the three kits are all used to measure microorganisms. One would have been motivated to make the modification because it will speedup the measurement, and would reasonably have expected success in view of both Trudil and Tanaka's teachings. The adjustment of particular conventional working conditions (e.g., choice of particular filtering accelerating agent, solvent to dissolve bacteriolytic agent) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan having the cited reference before him/her.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Art Unit: 1657

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**Conclusion**

5. No claim is allowed.

Certain papers related to this application may be submitted to Art Unit 1657 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify

Art Unit: 1657

applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Bin Shen, Ph.D., whose telephone number is (571) 272-9040. The examiner can normally be reached on Monday through Friday, from about 9:00 AM to about 5:30 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to her office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached at (571) 272-0925.



RALPH GITOMER  
PRIMARY EXAMINER  
GROUP 1200

*BS*hen

Art Unit 1657